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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,369	10/23/2000	Wenfeng Xu	99-75	2902

7590

03/12/2003

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EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 03/12/2003

(1)

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,369

Applicant(s)

XU ET AL.

Examiner

Sally A Sakelaris

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <u>3</u> Sequence alignments. |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group II, claims 9-16 and 35-38 in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

Acknowledgement of the claim to priority of the provisional application(s) drawn to this same subject matter has been made. The filing date of instant claims 9, 13, 14, 15, 16, and 35 is deemed to be the filing date of the provisional application 60/160,880 filed 10/22/1999 while claims 10, 11, 12, 36, 37, and 38 have been granted priority to the provisional application 60/222,221 filed 8/01/2000.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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1. Claims 9, 11, 12, 13-16, 35, 37, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Murphy et al.(Published Patent Application, US 2002/0143147 A1).

Murphy et al. teach an isolated polynucleotide that encodes the polypeptide **comprising and consisting of** residues 2 to 129 of the present application's SEQ ID NO:2(Please see Result 1 of attached alignment of SEQ ID NO:2 residues 2-129 and SEQ ID NO: 18 residues 81-464 from Murphy et al.). The reference further teaches an isolated polynucleotide that encodes the polypeptide **comprising and consisting of** residues 1 to 173 of SEQ ID NO: 38, thereby also teaching residues 1 to 147, 1 to 154, 1 to 163, and 1-165 of SEQ ID NO: 38(Please see Result 1 of attached alignment of SEQ ID NO: 38 residues 1-173 and SEQ ID NO: 18 residues 78-687 from Murphy et al.). Additionally, Murphy et al. teach sequences encoding proteins which exhibit sequence similarity to Tumor Necrosis Factor(TNF) receptors through an expression vector comprising a transcription promoter, a DNA segment wherein the DNA segment is a polynucleotide molecule encoding the polypeptide molecule of claim 9 and a transcription terminator(Pages 2 and 3). The reference further teaches methods of synthesizing proteins by culturing a cell containing a vector comprising said polynucleotide and recovering the synthesized protein(Page 22).

It should be noted that Claims 11, 12, 37 and 38 are broadly drawn to **all** nucleic acids encoding the delineated residues of the amino acid sequence SEQ ID NO:38. The nucleic acid encoding SEQ ID NO: 38 could in fact, include an internal sequence that is subsequently spliced out from the resulting amino acid during translation. In absence of evidence to the contrary, the presently cited nucleic acids of Murphy et al. successfully anticipate a possible variant existing

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prior to a splicing event of SEQ ID NO: 38. As a result, all residues claimed of SEQ ID NO 38 are anticipated.

2. Claims 10 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (Published Patent Application, US 2002/0168674 A1).

Chui et al. teach an isolated polynucleotide that encodes the polypeptide **comprising and consisting of** residues 1 to 267 of SEQ ID NO: 29. Chui et al. teach SEQ ID NO: 11 whose nucleotides, 1-900 share 100% identity to residues 1 to 267 of SEQ ID NO: 29 (Please see attached alignment Result 1). It should be noted that Claims 10 and 36 are broadly drawn to **all** nucleic acids encoding residues 1-267 of the amino acid sequence SEQ ID NO: 29. The nucleic acid encoding SEQ ID NO: 29 could in fact, include an internal sequence that is subsequently spliced out from the resulting amino acid during translation. In absence of evidence to the contrary, the presently cited nucleic acids of Chui et al. successfully anticipate a possible variant existing prior to a splicing event of SEQ ID NO: 29. As a result, claims 10 and 36 reciting residues 1-267 of SEQ ID NO: 29 are anticipated.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Thursday from 7:30AM-5:00PM and Friday from 1:00PM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The fax number for the Technology Center is (703) 305-3014 or (703) 305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703) 605-1237.

Sally Sakelaris

Sally Sakelaris
2/5/03

Carla Myers
CARLA J. MYERS
PRIMARY EXAMINER

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